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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,675	06/28/2001	Robert Gordon	19388-P005US	6876

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James J. Murphy
1201 Elm, 54th Fl.
Dallas, TX 75270

EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/895,675	Applicant(s) GORDON ET AL.	
	Examiner Janice A. Mooneyham	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on June 28, 2001, wherein claims 1-20 are currently pending in this application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable in view of a printed publication from eShare Technologies, Inc. titled "eShare Expressions" (hereinafter referred to as eShare) in view of a printed publication Beyond Woolf: The Virtual Court House (hereinafter referred to as Woolf) and further in view of ADRWorld.com (hereinafter referred to as ADR).

Regarding Claim 1:

eShare discloses an online method comprising the steps of:

setting up a main chat room (public chat room) accessible to a professional and first and second parties (*page 1 see Improved Rooms: create **public** rooms that suite the specific needs of your community; page 3 Chat: users can communicate in real-time, create rooms and join moderated (professional) events; Forums: Users can post, reply, and attach files on public password-protected discussion forums*).

setting up a private chat room accessible by a selected one of the parties and counsel for the selected party for conducting private information exchanges (*page 1*

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*Improved Rooms: Create **private** rooms in any combination that suits the specific need of your community); and*

conducting the procedure through the exchange of information through chat in the main chat room (*page 1 Encourage the exchange of ideas and information; page 4 eShare interaction suite is an award winning, turnkey solution for adding chat, threaded discussion forums and online presentations to web sites. It enables organizations to promote community, collaboration and the kind of dynamic interaction that is crucial for commercial activity. Use it for virtual meetings, live training and conferencing, distance learning, moderated events, and social chats*)

Although eShare discloses a website that is a turnkey solution for adding chat, threaded discussion forums and online presentations to the website for making it useful for virtual meetings, online training and moderated events (page 4) and live audio and streaming video (page 1), eShare does not explicitly disclose activating a virtual presenter for presenting evidence and the presentation of evidence using the virtual presenter.

However, Woolf discloses a virtual presenter for presenting evidence and the presentation of evidence using the virtual presenter (*see page 3 "The Trial" technology based management and presentation of documentary evidence at the hearing; disputed testimony via live video conferencing link*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the virtual evidence presentation of Woolf with the real-time communication forum of eShare so as to streamline and improve the existing justice

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system and process and to aid in getting the antiquated, expensive and delay ridden system back in order.

eShare does not disclose online procedure being an alternate dispute resolution procedure or selecting an alternate dispute resolution professional.

However, ADR discloses providing online alternate dispute resolution information and selecting an alternate dispute resolution professional (*page 1 with detailed profiles and advanced search capabilities, ADRWorld.com's online database – the ADR Exchange – is a powerful tool for quickly locating arbitrators, mediators and attorneys; an easy and efficient way of finding qualified dispute resolution professionals; launch of a searchable online directory of arbitrators, mediators and attorneys to help the business community and the public find qualified dispute resolution professionals*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the alternative dispute resolution resource of ADR with the real-time communication forum of eShare so as to provide the broader public an easy and efficient way of resolving disputes and finding qualified dispute resolution professionals at a time of rapid growth of arbitration, mediation and other forms of alternative dispute resolution in lieu of litigation.

Regarding Claim 2:

eShare discloses a method wherein said steps of setting-up main and private chat rooms comprise the steps of setting up chat rooms accessible by a global computer network selected from the group comprising the Internet and World Wide Web (*page 4 The eShare Expressions Server enables users to perform a wide-range of real-*

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time community tasks. Users perform all function through any standard web browser.

Chat: Users can communicate in real-time, create rooms, group "peers," and join moderated events).

Regarding Claim 3:

ADR discloses a method wherein the selected alternate dispute resolution procedure is selected from the group comprising arbitration, mediation, summary jury trial and focus group trial (*page 1 launch of a searchable online directory of arbitrators, mediators and attorneys to help the business community and the public find qualified dispute resolution professionals; ADR is a powerful tool for quickly locating arbitrators, mediators, and attorneys by their practice area, location, expertise and qualifications*).

Regarding Claim 4:

Woolf discloses a selected dispute resolution procedure comprising a method of performing a selected dispute resolution procedure online in preparation for a subsequent procedure (*page 3 case management hearings and appeals can be dealt with remotely using IT, why not first instance hearings – and appeals by way of a rehearing*).

Regarding Claim 5:

ADR discloses the step of selecting at least one alternate dispute professional comprises searching profiles in an electronic database (*page 1 with detailed profiles and advanced search capabilities, ADRWorld.com's online database – the ADR Exchange – is a powerful tool for quickly locating arbitrators, mediators and attorneys; an easy and efficient way of finding qualified dispute resolution professionals; launch of*

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a searchable online directory of arbitrators, mediators and attorneys to help the business community and the public find qualified dispute resolution professionals).

Regarding Claim 6:

Woolf discloses a virtual presenter operable to present evidence in a form selected from the group comprising video-deposition testimony, documents, photographs, graphics exhibits, audio statements and computer reconstructions (page 3 *"The Trial" the use of technology based management and presentation of documentary evidence at the hearing; computer aided transcription of spoken evidence; means of video conferencing; computerized management of documentary evidence; receipt of disputed testimony via a live video conferencing link).*

Regarding Claim 7:

Woolf discloses a virtual presenter operable to present arguments of lawyers (page 3 *"The Trial" - an appeal hearing takes the form of the presentation of written or spoken argument by lawyers followed by decision, is there any compelling reason why such activities cannot be conducted fairly and efficiently by video conferencing).*

Regarding Claim 8:

Woolf discloses a method further comprising the step of performing a post-procedure analysis (page 2 *Preparation for Trial Case tracking will be achieved through electronic facilities such as progress reports, lists of outstanding tasks and notice of who has responsibility for taking the next; page 3 electronic case files providing a key additional benefit - a valuable by product, management information about trends, case-types, costs and administrative bottlenecks).*

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Regarding Claim 9:

Woolf discloses a method wherein said step of performing a post-procedure analysis comprises the sub-steps of:

creating a session record concurrent with said step of conducting the dispute resolution procedure (*pages 2-3 Preparation for Trial – electronic case histories; electronic case files; page 3 The Trial – instantaneous, computer aided transcription of spoken evidence*), and

performing content analysis on the session record (*page 4 The Trial – instantaneous computer analysis of a witness's voice patterns; remote sensing of skin moisture, pulse rate and heart beat*).

Regarding Claim 10:

Woolf discloses a method further comprising the step of selecting a focus group for analyzing the dispute resolution procedure (*page 3 Trial Preparation – by gathering statistical information about the flow of cases through courts and tribunals will provide the raw data with which the court administration, armed with logistical planning and management tools, can achieve the fairest, cheapest, and most efficient allocation of time and resources*).

3. Claims 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over eShare.

Regarding Claim 11:

eShare discloses a computer network for implementing procedures

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comprising:

a plurality of interconnected terminals operable to:

maintain a chat room for exchanging information between a professional and a plurality of parties (*page 1 Improved Rooms: Create **public**, private, moderated, password-protected, and user created rooms in an combination that suits the specific needs of your community; Multiple client interaction; Chat Moderation: Run scheduled events in a moderated room*);

maintain a chat room for exchanging confidential information between said professional and a first one of said parties (*page 1 create **private** rooms; page 3 Chat; users can communicate in real time, create rooms, group "peers," and moderated events*); and

maintain a room for exchanging confidential information between said professional and second one of said parties (*page 1 create private rooms; users can communicate in real time, user created rooms*).

eShare does not explicitly disclose three chat rooms. However, eShare discloses public and private user created rooms in any combination that suits the needs of the community (*page 1 Improved rooms*). eShare also discloses and Inter-row toggle feature wherein members may chat amongst themselves with their "row" or room during an event (*page 2*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate several chat rooms for exchanging confidential information so that the parties can each side have a discussion among the participants

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without the other side or the attorney being involved and the parties can then have a discussion between them and their attorney without the other side being privy to the information since this most simulates a real live dispute resolution process where there are several layers of confidential conversations.

Regarding Claim 12:

eShare discloses a computer network wherein said network is further operable to maintain a virtual caucus room for exchanging information between a selected parties *(page 1 create private rooms; page 2 Inter-row toggle feature – members may chat amongst themselves with their “row” or room during the event; page 3 Chat; users can communicate in real time, create rooms, group “peers,” and moderated events)*.

eShare does not disclose that the communication is between the parties and counsel for the parties.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate several chat rooms for exchanging confidential information so that the parties can each side have a discussion among the participants without the other side or the attorney being involved and the parties can then have a discussion between them and their attorney without the other side being privy to the information since this most simulates a real live dispute resolution process.

Regarding Claim 13:

eShare discloses a computer network wherein said network implements a presenter operable to present audio and visual presentations to selected ones of the parties and the professional through corresponding ones of said terminals *(page 1 – live*

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audio and streaming video – users will enjoy the rich dimension of sound and video while they chat within the community).

Regarding Claim 14:

eShare discloses a computer network wherein at least one of said terminals communicates with said server via a global computer network selected from the group comprising the Internet and World Wide Web (*page 3 The eShare Expressions Server enables users to perform a wide-range of real-time community tasks. Users perform all functions through any standard web browser).*

Regarding Claim 15:

eShare discloses a computer network wherein said first chat room simulates an assembly room (*page 1 Improved rooms: public rooms).*

Regarding Claim 16:

eShare discloses a computer network wherein the professional communicates with said parties through said second and third chat rooms via pop-up screens (*eShare discloses Java Light Chat (page 1) Java allows for the creation of pop-up screens).*

Regarding Claims 17 and 18:

EShare disclose a computer network further comprising a database (*page 3 Database support*) The fact that the database is for selecting a dispute resolution professional or a settlement scientist for analyzing the dispute resolution is the intended use of the database. An apparatus must be distinguished from the prior art in terms of structure rather than function alone. The Examiner has reason to believe that the

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database of eShare is capable of performing the function of storing a listing of dispute resolution professionals, as well as a list of settlement scientist).

4. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over eShare as applied to claim 11 above, and further in view of Woolf.

Regarding Claims 19 and 20:

EShare discloses and Expressions Server which enables users to perform a wide-range of real-time community tasks (page 3). However, eShare does not discloses simulating a courtroom or jury deliberations.

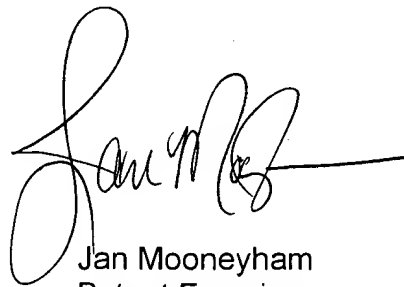
Woolf discloses a computer network simulating a courtroom (*The Virtual Court House pages 3-4 The Trial*) and jury deliberations (*The Virtual Court House pages 4-5 Juries – virtual jury*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the courtroom/jury disclosure of Woolf with the real-time communication forum of eShare since using IT will assist in streamlining and improving the existing system and process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a long horizontal line extending to the right.

Jan Mooneyham
Patent Examiner
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